

**REMARKS**

Claims 1-4 are all the claims pending in the application. By this amendment, claim 1 is proposed to be canceled as indicated above and in the Appendix. The substance of claim 1 is proposed to be incorporated into claim 2 as shown. Since claim 2 has now essentially been made independent, its scope has not been narrowed. Also, the dependency of remaining claims 3 and 4 is proposed to be changed from canceled claim 1, to amended claim 2.

Entry of these amendments is respectfully requested. No new issues requiring further search or consideration are deemed to be raised, nor is new matter presented. Further, the amendments will advance prosecution and narrow the issues for appeal should one become necessary.

On page 2 of the Office Action, the Examiner rejects claims 1, 3 and 4 under 35 U.S.C. § 102(b) as being anticipated by Mamish (U.S. Patent No. 5,227,225). This rejection has been maintained and the basis for this rejection can be found in Paper No. 7.

In paragraph 6 at pages 3-4 of the Office Action, the Examiner includes a detailed response to the arguments presented in the last Amendment.

Applicants respectfully submit that since all claims now include the limitations of claim 2, not rejected on this ground, the anticipation rejection no longer applies. Accordingly, its withdrawal is respectfully requested.

On page 2 of the Office Action, the Examiner rejects claims 1-4 under 35 U.S.C. § 103(a) as being unpatentable over Mamish ('225). This rejection has been maintained and the basis for this rejection can be found in Paper No. 7.

RECEIVED  
MAR 21 2009  
TECHNOLOGY CENTER 1708

In paragraph 7 at page 4 of the Office Action, the Examiner includes a response to the arguments presented in the last Amendment.

This rejection is respectfully traversed.

Applicants respectfully traverse this rejection and submit that the Examiner has not established a prima facie case of obviousness, i.e., the Examiner has not established that Mamish discloses the structure and properties of the sheet of claim 2, and why one of ordinary skill in the art would have been motivated to use a basis weight of from 5 to 100g/m<sup>2</sup> from the teachings of Mamish.

Applicants' specification (see page 5) discloses that the recited basis weight provides for the protection of paint films from colliding matters (dust, dirt, etc.), peeling workability after achieving the desired protection, strength, and wrinkle-free adhesion. Mamish may teach the use of the masking tape disclosed therein with reference to the application of paint to automobiles. Specifically, the Mamish masking tape may be used to cover areas on which paint is not desired. The masking tape is described as providing "cleaner lines of paint."

Therefore, Applicants respectfully submit that the Mamish disclosure is not concerned with the protection of paint films from colliding matters, peeling workability after achieving the desired protection, strength and wrinkle-free adhesion, as in the present invention. Accordingly, Mamish does not provide any motivation to use a fabric having the basis weight recited in Applicants' claims. The Examiner's conclusions appear to be based on the impermissible use of hindsight.

AMENDMENT  
U.S. Appln. No. 09/311,753

For these reasons, Applicants traverse the rejection and respectfully request the withdrawal thereof.

On page 2 of the Office Action, the Examiner rejects claims 1-4 under 35 U.S.C. § 103(a) as being unpatentable over Shirai et al ('054). This rejection has been maintained and the basis for this rejection can be found in Paper No. 7.

In paragraph 8 at page 5 of the Office Action, the Examiner has included a response to the arguments presented in the last Amendment.

This rejection is respectfully traversed.

There is no disclosure in the Shirai reference that teaches or suggests the use of a polymer film and a non-woven fabric. The Examiner refers to Example 1 of Shirai, but in Example 1 no non-woven fabric is used. Nor is the basis weight disclosed or suggested in the manner presently claimed.

Moreover, Applicants' claimed invention does not involve "the mere duplication of layers" as suggested by the Examiner but, rather, is based on the combination of different layers. Applicants' specification (see page 4) discloses that neither a non-woven fabric alone nor a film alone provide satisfactory protection of automotive paint films. The combination of the components provide the superior characteristics of Applicants' claimed invention.

Furthermore, even if, *arguendo*, Shirai could be reasonably interpreted as teaching the combination of a polymer film and a non-woven fabric, the reference does not teach that the pressure sensitive adhesive is formed on the surface of the polymer film (rather than on the non-woven fabric), as recited in Applicants' claim 1. The Examiner's rejection of claims 1-4 appears

AMENDMENT  
U.S. Appln. No. 09/311,753

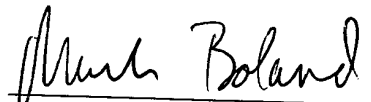
to be based on an "obvious to try" rationale and the impermissible use of hindsight with the benefit of the teachings in Applicants' specification.

For these reasons, Applicants respectfully traverse this rejection and respectfully request the withdrawal thereof.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this case, and any required fee, except for the Issue Fee, for such extension is to be charged to Deposit Account No. 19-4880.

Respectfully submitted,



Mark Boland  
Registration No. 32,197

SUGHRUE, MION, ZINN,  
MACPEAK & SEAS, PLLC  
2100 Pennsylvania Avenue, N.W.  
Washington, D.C. 20037-3213  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

Date: March 19, 2001

**APPENDIX**

**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**IN THE CLAIMS:**

**Claim 1 is canceled, with prejudice or disclaimer.**

**The claims are amended as follows:**

2. (amended) [The] A sheet for protecting paint films of automobiles [as claimed in claim 1], which comprises a support comprising a polymer film laminated on one or both surfaces of a non-woven fabric, and a pressure-sensitive adhesive layer formed on one surface of said polymer film, wherein said non-woven fabric has a basis weight of from 5 to 100 g/m<sup>2</sup>.

3. (amended) The sheet for protecting paint films of automobiles as claimed in claim [1] 2, wherein said polymer film has a thickness of from 5 to 40 μm.

4. (amended) The sheet for protecting paint films of automobiles as claimed in claim [1] 2, wherein said polymer film comprises a thermoplastic polymer.